



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
[www.uspto.gov](http://www.uspto.gov)

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/706,766	11/12/2003	James D. Ralph	F-296	7793
51640	7590	07/18/2005	EXAMINER	
LERNER, DAVID, LITTENBERG, KRUMHOLZ & MENTLIK, LLP 600 SOUTH AVENUE WEST WESTFIELD, NJ 07090				BLANCO, JAVIER G
ART UNIT		PAPER NUMBER		
3738				

DATE MAILED: 07/18/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	10/706,766	RALPH ET AL.
	Examiner	Art Unit
	Javier G. Blanco	3738

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 18 April 2005.

2a) This action is FINAL.                    2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1,2 and 5 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 1,2 and 5 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) Notice of References Cited (PTO-892)  
 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)  
 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 4/18/2005.

4) Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.  
 5) Notice of Informal Patent Application (PTO-152)  
 6) Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Response to Amendment***

1. Applicant's amendment of claims 1, 2, and 5 in the reply filed on April 18, 2005 is acknowledged.

### ***Terminal Disclaimer***

2. The terminal disclaimer filed on April 18, 2005 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of US 6,645,249 has been reviewed and is accepted. The terminal disclaimer has been recorded.

### ***Claim Objections***

3. Claim 1 is objected to because of the following informality (typographical error): please substitute "eternal" (see line 11) with --external--. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.  
(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

5. Claims 1, 2, and 5 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Caenen et al. (FR 2 718 635 A1).

As seen in Figures 4-6 and 10, Caenen et al. disclose an intervertebral spacer device comprising first (character 1) and second (character 2) plate members and at least one multi-pronged domed spring (core 3) disposed between the inner surfaces of plates 1 and 2 (see entire document). Merriam-Webster dictionary defines “pronged” as “*having a usually specified number of prongs*” and “prongs” as “*a slender pointed or projecting part*”. Dictionary.com defines “pronged” as “*having prongs or tines*” or “*resembling a fork; divided or separated into two branches*”. As seen in Figures 4-6 and 10, core 3 contains at least two lateral wings or ribs 16 branching/projecting from core’s body 14.

6. Claims 1 and 2 are rejected under 35 U.S.C. 102(a) as being clearly anticipated by Marnay et al. (WO 01/01893 A1).

As seen in Figures 1, 3, and 7, Marnay et al. disclose an intervertebral spacer device comprising first (character 2) and second (character 3) plate members and at least one multi-pronged domed spring (“joint employment” 4) disposed between the inner surfaces of plates 2 and 3 (see entire document). Merriam-Webster dictionary defines “pronged” as “*having a usually specified number of prongs*” and “prongs” as “*a slender pointed or projecting part*”. Dictionary.com defines “pronged” as “*having prongs or tines*” or “*resembling a fork; divided or separated into two branches*”. As seen in Figure 1, joint employment 4 (= domed spring) contains at least two guide rails 26 and a rest projection 28 branching/projecting from the spring’s body.

***Response to Arguments***

7. Applicant's arguments filed April 18, 2005 have been fully considered but they are not persuasive.

Applicants argue that core 3 (Figures 4-6 and 10) of Caenen et al. (FR 2 718 635 A1) does not have a spring-like action or that it does not counteracts compressive loads applied to the external surfaces of the plate members. Examiner respectfully disagrees. It should be noted that Caenen et al. disclose core 3 as made from polyethylene (see page 4, lines 12-15; see entire document). Polyethylene, as well as other spacer/spring materials, has a modulus of elasticity that is inherently resilient (to some degree/extent) to compressive loads applied to the external surfaces of the plate members. Core 3 is capable of counteracting compressive loads applied to the external surfaces of the plate members.

**Note:** Claims directed to apparatus must be distinguished from the prior art in terms of structure rather than function. *In re Danly*, 263 F.2d 844, 847, 120 USPQ 528, 531 (CCPA1959).

"[A]pparatus claims cover what a device is, not what a device does." *Hewlett-Packard Co. v. Bausch & Lomb Inc.*, 909 F.2d 1464, 1469, 15 USPQ2d 1525, 1528 (Fed. Cir. 1990).

Expressions relating the apparatus to contents thereof during an intended operation are of no significance in determining patentability of the apparatus claim. *Ex parte Thibault*, 164 USPQ 666, 667 (Bd. App. 1969).

8. Applicant's arguments filed April 18, 2005 have been fully considered but they are not persuasive.

Applicants argue that "joint employment" 4 (Figures 1, 3, and 7) of Marnay et al. (WO 01/01893 A1) does not have a spring-like action or that it does not counteracts compressive loads

Art Unit: 3738

applied to the external surfaces of the plate members. Examiner respectfully disagrees. It should be noted that Marnay et al. disclose "joint employment" 4 as made from polyethylene (see page 12, last paragraph; see entire document). Polyethylene, as well as other spacer/spring materials, has a modulus of elasticity that is inherently resilient (to some degree/extent) to compressive loads applied to the external surfaces of the plate members. "Joint employment" 4 is capable of counteracting compressive loads applied to the external surfaces of the plate members.

**Note:** Claims directed to apparatus must be distinguished from the prior art in terms of structure rather than function. *In re Danly*, 263 F.2d 844, 847, 120 USPQ 528, 531 (CCPA1959).

"[A]pparatus claims cover what a device is, not what a device does." *Hewlett-Packard Co. v. Bausch & Lomb Inc.*, 909 F.2d 1464, 1469, 15 USPQ2d 1525, 1528 (Fed. Cir. 1990).

Expressions relating the apparatus to contents thereof during an intended operation are of no significance in determining patentability of the apparatus claim. *Ex parte Thibault*, 164 USPQ 666, 667 (Bd. App. 1969).

### *Conclusion*

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37

Art Unit: 3738

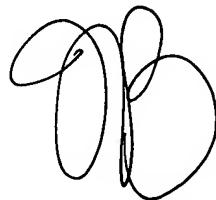
CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Javier G. Blanco whose telephone number is 571-272-4747. The examiner can normally be reached on M-F (7:30 a.m.-4:00 p.m.), first Friday of the bi-week off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Corrine McDermott can be reached on (571) 272-4754. The fax phone numbers for the organization where this application or proceeding is assigned is 703-872-9306 for regular communications and After Final communications. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0858.

JGB

July 8, 2005



David H. Willse  
Primary Examiner